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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,190	07/19/2006	Peter Bloch	2002P16539WOUS	2691

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

SMITH, NICHOLAS A

ART UNIT	PAPER NUMBER
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1795

MAIL DATE	DELIVERY MODE
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02/02/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,190	Applicant(s) BLOCH ET AL.	
	Examiner NICHOLAS A. SMITH	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/16/05</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johns et al. (US 3723268 A) in view of Hill (US 4468304 A).

3. Johns et al. discloses a process for electrolytically re-machining a bore in a component with a layer that needs to be removed in which a material removing-agent (acid electrolyte) flows through the bore and a surface arranged around the bore in the component is protected from removal of material, comprising wherein an electrode arranged in the vicinity of the bore in such a way that only material in the region in the vicinity of the bore, comprising electrolyte flowing through the bore from the inside outward (col. 5, line 60 to col. 6, line 22; Figure 10).

4. However, Johns et al. does not explicitly disclose protecting the surface by a masking or protecting by diluting the material removing-agent by spraying water.

5. Hill discloses a method of electrochemical re-machining wherein non-machined area is protected by one of a protective anode, a masking or protecting by diluting the material removing-agent by spraying water (col. 1, line 10-37; Figure) It would have been obvious to one of ordinary skill in the art to modify Johns et al. with Hill's protecting by diluting and/or masking because Hill teaches that such are effective methods for protecting an area of a part from unwanted machining (Hill, col.1, line 10-37).

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6. Claims 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johns et al. in view of Hill in further view of Ozaki et al. (US 5143586 A).

7. Johns et al. in view of Hill does not explicitly disclose pulsed electrochemical machining.

8. Ozaki et al. discloses a method of pulsed electrochemical machining on a workpiece (col. 5, line 25-61). It would have been obvious to one of ordinary skill in the art to modify the method of Johns et al. in view of Hill with Ozaki et al.'s pulsed electrochemical machining because Ozaki et al. teaches that such a method provides accurate part dimensions (Ozaki et al., col. 5, line 25-61).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Uzoh (US 6056869 A) pertains to protecting a metallic surface from machining with water flowing. Andrews (US 3793170 A) pertains to machining a bore and protecting a surface from machining.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICHOLAS A. SMITH whose telephone number is (571)272-8760. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexa Neckel can be reached on (571)-272-1446. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/
Primary Examiner, Art Unit 1795

NAS